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In re Application of	:	
Grant et al	:	DECISION ON
Int. Application: PCT/US2003/38862	:	
Application No.: 10/538,161	:	
Int. Filing Date: 08 December 2003	:	REQUEST UNDER
Priority Date: 08 December 2002	:	
Attorney's Docket No.: IMMR-0152D	:	
For: METHOD AND APPARATUS FOR...	:	
COMMUNICATION DEVICES	:	37 CFR 1.497(d)

This is a decision on applicants' "PETITION TO CORRECT INVENTORSHIP UNDER 37 CFR 1.497" filed on 19 June 2006, to add joint inventors Eric SHAHOIAN and Dean CHANG in the executed declaration.

**BACKGROUND**

On 08 December 2003, applicants filed international application No.: PCT/US2003/38862, which claims a priority date of 08 December 2002.

On 08 June 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee. No executed oath or declaration was filed at such time.

On 18 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, *inter alia*, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.47(a) and (b), identifying the application by International application number and international filing date" must be submitted within two months from the date of mailing of this notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 19 June 2006, applicants filed a "PETITION TO ADD INVENTORS UNDER 37 CFR 1.497," which included, *inter alia*, statements to add joint inventors Eric SHAHOIAN and Dean CHANG in the executed declaration.

### **DISCUSSION**

A submission under 37 CFR 1.497(d) must include:

- (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) the fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (1) - (3) under 37 CFR 1.497(d).

With respect to item (1), the statements submitted on 19 June 2006 by Eric SHAHOIAN and Dean CHANG are sufficient because the statements state that the error in inventorship occurred without a deceptive intent.

With respect to item (2), the processing fee of \$130.00 has been paid by check.

With respect to item (3), Immersion Corporation, the assignee, consents to the correction of inventorship to the above application and it has filed in the requisite papers (i.e., executed assignment) establishing their right to take action under 37 CFR §3.73(b).

Accordingly, the requests are deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

However, for the reason below, the application may not enter into national stage processing at this time. The declaration filed on 19 June 2006 is defective since it does not comply with 37 CFR 1.497(a)(3). A Declaration, under 37 CFR 1.497(a)(3), must identify each inventor. See MPEP § 602. In this instance, applicants submitted a composite declaration comprising of five sets of declarations, which four are incomplete because each set must be complete by having the correct number of pages and listing all the inventors. In this case only, one set is complete because it comprises of the four (4) pages of the declaration. The other sets are incomplete because they only contain page 4 and they do not have the other pages of the Declaration to make them complete. Therefore the composite Declaration is incomplete.

Copies of the same page is not part of a proper declaration since it is considered a composite declaration and each must be a complete declaration with the proper statement and the names of each inventor even though each set of declarations may not have all the signatures of the inventors. Therefore, a proper declaration must consist of individual complete sets of declaration that taken as a whole would have all the required signatures as required under 37 CFR 1.497(a)(3).

### **CONCLUSION**

For the reasons above, the request under 37 CFR 1.497(d) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision.

A handwritten signature in black ink, appearing to read 'R. Bacares', is written over the printed name.

Rafael Bacares

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